

REMARKS

Reexamination and reconsideration of the claims 1-15, 17-29, and 31-45 is respectfully requested. Claims 16 and 30 have been cancelled without prejudice. Additionally, Applicants acknowledged and appreciate the Examiner's consideration of the submitted Information Disclosure Statement.

Claims 26 and 43 were rejected under 35 U.S.C. sec. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claims 26 and 43 have been amended to remove any indefiniteness that may have existed. Moreover, the amendment of claims 26 and 43 is not an admission that the art of record teaches, discloses, or otherwise suggests the features of the claims. Withdrawal of the sec. 112 rejection, second paragraph, of claims 26 and 43 is respectfully requested.

Claims 15, 17, 18, 20, and 25-28 were rejected under 35 U.S.C. sec. 102(b) applying U.S. Pat. No. 5,394,904 (the '904 patent). For a patent to be applicable under sec. 102(b), the patent must, *inter alia*, disclose each and every feature of the claimed invention.

It is respectfully submitted that the '904 patent does not teach each and every feature of amended claim 15. Additionally, the amendment of claim 15 is not an admission that the art of record teaches, discloses, or otherwise suggests the features of the claim. Specifically, claim 15 recites that the jacket is formed from a foamed material that is compressible so when the duct is placed within the channel a major dimension of the jacket is capable of being compressed by about five percent or more.

The Office Action incorrectly states that a jacket 28 of the '904 patent is "...formed from a material that is compressible so that when the duct is placed within the channel the jacket material is capable of being compressed, thereby forming a friction fit between the duct and the channel (col. 4, lines 50

10/724,445

C0034

Page 9

through 66);..." See p. 3 of the Office Action. This assertion is not supported any objective evidence of record. Rather, the passage cited at Col. 4, ll. 50-66 for this proposition states the following:

Referring now to FIG. 1, the new flexible hose construction of this invention is generally indicated by the reference numeral 20 and comprises an inner corrugated hose 21 formed of any suitable polymeric material and having a plurality of outwardly convex projections 22 with recesses 23 therebetween and extending from one end 24 to the other end 25 thereof, a tube 26 of any suitable polymeric material extending in a generally straight-line manner from projection 22 to projection 22 as illustrated in FIG. 3, an outer sleeve 27 of reinforcing material disposed in telescoping relation on the tube 26, and an outer layer 28 of any suitable polymeric material that will provide a protection for the sleeve 27 of reinforcing material and also tend to prevent any liquid that is conveyed through the flexible hose construction 20 from permeating to the exterior thereof, such as gasoline and the like.

As depicted by the objective evidence of record, the cited passage does not disclose that outer layer 28 being formed from a compressible material such as a foamed material as recited in claim 15. Instead, the passage states hose 20 is for conveying fluid such as gasoline and the like and that outer layer 28 is a polymeric material that provides protection and prevents any liquid that is conveyed through the flexible hose construction 20 from permeating to the exterior thereof.

A foamed material that is compressible as recited in claim 15 would not prevent permeating of liquid such as gasoline and the like. This is because a foamed material has cells of air pockets that would make permeation of liquid easier compared with a non-foamed material. Furthermore, compressing a foamed material would not be helpful in preventing permeation of liquid. Thus, the '904 patent does not disclose, teach, or otherwise suggest each and every feature of amended claim 15. Rather, the '904 patent teaches away from using a foamed material for outer

10/724,445

C0034

Page 10

layer 28 because the '904 patent discloses preventing permeation of liquid through outer layer 28. For at least this reason, the withdrawal of the sec. 102(b) rejection of claims 15, 17, 18, 20, and 25-28 is warranted and respectfully requested.

Claims 16, 19, 21 and 22-24 were rejected under 35 U.S.C. sec. 103(a) applying the '904 patent without a teaching reference. For a patent to be applicable under sec. 103(a), the combination of teachings must, *inter alia*, expressly or inherently, teach, disclose, or otherwise suggest each and every feature of the claimed invention. Additionally, motivation and suggestion to combine the teachings must be present.

It is respectfully submitted that the '904 patent does not teach, disclose, or otherwise suggest each and every feature of claims 16, 19, 21, and 22-24 for at least the reasons stated above for amended claim 15. For at least this reason a *prima facie* case of obviousness with respect to amended claim 15 and its dependent claims is lacking.

Again, the Office Action cites the same passage (Col. 4, ll. 50-66) from the '904 patent stating that jacket 26I (Fig. 23) is formed from a material that is compressible. See p. 5 of the Office Action. First, layer 26I is not the outer layer of hose 20I, rather it is an inner layer and layer 28I is the outer layer. Additionally, even if a material disposed radially inward of outer layer 28I was compressible it would not make the hose of the '904 patent compressible because outer layer 28I is formed from a relatively rigid material that provides protection and prevents permeation of gasoline and other volatile liquids, thereby inhibiting compression of the outer layer 28. See Col. 4, ll. 60-66 of the '904 patent. Thus, the withdrawal of the sec. 103(a) rejection of claims 16, 19, 21 and 22-24 is warranted and respectfully requested.

Claims 1-13 and 29-45 were rejected under 35 U.S.C. sec. 103(a) applying U.S. Pat. No. 4,896,997 (the '997 patent) in view

of the '904 patent. For patents to be applicable under sec. 103(a), the combination of teachings must, *inter alia*, expressly or inherently, teach, disclose, or otherwise suggest each and every feature of the claimed invention. Additionally, motivation and suggestion to combine the patents must be present.

It is respectfully submitted that the purported modification does not teach, disclose, or otherwise suggest each and every limitation of independent claims 1, 29, and 38. Moreover, the amendment of claim 29, or any other claim, is not an admission that the art of record teaches, discloses, or otherwise suggests the features of the claim.

Specifically, claims 1 and 38 recite a channel defined by a paved surface and claim 29 recites forming a channel in a paved surface. Paved surface is defined in the specification as meaning asphalt, bitumen, concrete, cement, laid stones, bricks or tiles, expansion joints, combinations thereof or other similiarly suited solid construction materials. See p.3 of the present application. On the other hand, the '997 patent teaches plowing a cable into the earth as discussed and shown in the Figures. See Col. 4, ll. 50-56 and Figs. 1 and 5 of the '997 patent. The earth is not a paved surface. Additionally, for the reasons stated above, hose 20 of the '904 patent does not have a jacket 28 that is compressible. Since the purported modification does teach, disclose, or otherwise suggest each and every limitation of claims 1, 29, and 38 a *prima facie* case of obviousness is lacking. Thus, the withdrawal of the sec. 103(a) rejection of claims 1-13, 29, and 31-45 is warranted and respectfully requested.

---

10/724,445

C0034

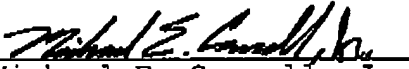
Page 12

No fees are believed due in connection with this Reply. If any fees are due in connection with this Reply, please charge any fees, or credit any overpayment, to Deposit Account Number 19-2167.

Allowance of all pending claims is believed to be warranted and is respectfully requested.

The Examiner is welcomed to telephone the undersigned to discuss the merits of this patent application.

Respectfully submitted,

  
Michael E. Carroll, Jr.  
Attorney  
Reg. No. 46,602  
P.O. Box 489  
Hickory, N. C. 28603  
Telephone: 828/901-6725

Date: October 20, 2004